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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,005

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EXAMINER

FANG, SHANE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,005	Applicant(s) MATSUOKA ET AL.	
	Examiner SHANE FANG	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The previously cited reference Wang et al. (US 5952433) has been included in current 892 form.

Response to Amendment

- The amendments of claims 5-7 and 12 of deleting the limitation of glycidyl ether have been found supported by the original claims.
- The previous 112 2nd rejections of claims 5-7 and 12 have been overcome by amendment.
- The previous 102 rejections of claims 1, 3, 9-11, 16, 18, and 20 over Casey et al. have been **maintained**.
- The previous 103 rejections of claims 2, 15, 17, and 19 over Casey et al. in view of Wang et al. have been **maintained**.
- The previous 103 rejections of claims 1, 8 and 14 over Deckwer et al. in view of Casey et al. have been **maintained**.
- The previous 103 rejections of claims 1-2 and 13 over Deckwer et al. in view of Casey et al. further view of Wang et al. have been **maintained**.
- The previous 103 rejections of claims 4-7 and 12 over Wang et al. in view of Casey et al. have been **maintained**.
- The previous ODP rejections of claims 1-4 and 8-11 and 13-20 over 12/312808 have been **maintained**.
- The previous ODP rejections of claims 1-3 and 8-11 and 13-20 over US 7449510 have been **maintained**.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 9-11, 16, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Casey et al. (US 3997512).

Disclosure of Casey et al. is adequately set forth in ¶3 of the last action and is incorporated herein by reference.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 15, 17, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Casey et al. (US 3997512) in view of Wang et al. (US 5952433) .

Disclosure of Casey et al. and Wang et al. are adequately set forth in ¶5 of the last action and are incorporated herein by reference.

5. Claims 1, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckwer et al. (US 5952433 A) in view of Casey et al. (US 3997512).

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Disclosure of Casey et al. and Decker et al. are adequately set forth in ¶6 of the last action and are incorporated herein by reference.

6. Claims 1-2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decker et al. (US 5952433 A) in view of Casey et al. (US 3997512) and in further view of Wang et al. (US 5952433).

Disclosure of Decker et al., Casey et al., and Wang et al. are adequately set forth in ¶7 of the last action and are incorporated herein by reference.

7. Claims 4-7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US 5952433) in view of Casey et al. (US 3997512).

Disclosure of Casey et al. and Wang et al. are adequately set forth in ¶8 of the last action and are incorporated herein by reference.

Claim Rejections - Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4 and 8-11 and 13-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 5-6 of copending Application No. 12/312808. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

See ¶10 of the last action.

10. Claims 1-3 and 8-11 and 13-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4 and 9-10 of US 7449510. This is a non-provisional obviousness-type double patenting rejection because the conflicting claims have in fact been patented.

See ¶11 of the last action.

Response to Arguments

The argument for allowance of amended claims has been fully considered but not persuasive.

The applicant has traversed the previous ODP rejections over later filed 12/312808 (Pg. 10, ¶7-Pg.11, ¶1). If two (or more) pending applications are filed, in each of which a rejection of one claimed invention over the other on the ground of

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provisional **>nonstatutory< double patenting (ODP) is proper, the >provisional< ODP rejection will be made in each application. If the >provisional< ODP rejection is the only rejection remaining in the earlier-filed of the two pending applications, (but the later-filed application is rejectable on other grounds), the examiner should then withdraw *>the provisional ODP< rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the >provisional< ODP rejection is the only rejection remaining in the later-filed application, (while the earlier-filed application is rejectable on other grounds), a terminal disclaimer must be required in the later-filed application, before the >provisional< ODP rejection can be withdrawn. If the >provisional< ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the >provisional< ODP rejection in the earlier-filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the >provisional< ODP rejection can be withdrawn and the application be permitted to issue. See MPEP- 1490 (V). D.

The applicant has traversed the previous ODP rejections over US 7449510 (Pg. 11, ¶2-5) for its silence on the claimed properties. This rejection is maintained based on the rationale of inherency as set forth in the last action. In view of the substantially identical composition, it appears that the adduct would have inherently possessed the claimed properties. See MPEP § 2112. In this particular case, no chemical or structural difference is shown between claimed and disclosed biodegradable polyester resin composition. The disclosed biodegradable polyester resin composition would inherently

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exhibit aforementioned claimed properties. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. A case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. See MPEP § 2184. In re **Fitzgerald**, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

The applicant has traversed the previous 102 rejections over Casey et al. for its disclosure of cured composition as being insoluble in chloroform so that said composition would be outside the claimed range of gelation index 1 and gelation index 2 (Pg. 6, ¶7-Pg.8, ¶3). The examiner disagrees. The present specification 0037 defines gelation index 1 and 2 (% of soluble composition residual) are measured on foaming or molding samples via chloroform and mesh screens, wherein the foaming or molding conditions are not well defined. The present specification 0070 merely shows the injection molding temperature of $T_m+10\text{ }^{\circ}\text{C}$ to $T_m+60\text{ }^{\circ}\text{C}$ and an exemplary temperature of $200\text{ }^{\circ}\text{C}$ without indicating the time of molding and the degree of crosslinking of the claimed composition. In contrast, Casey et al. disclosed the cured film (1 hour, $100\text{ }^{\circ}\text{C}$, in vacuum) is insoluble in chloroform. One of ordinary skill in the art would expect the degree of crosslinking would result in the difference in claimed gelation index. In light of this, the examiner has found the applicant fails to prove the disclosed composition of Casey et al. to be outside the claimed range of gelation index 1 and 2. The examiner

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affirms Casey et al. is silent on the claimed properties of gelation index 1 and 2 and previous inherency rationale for 102 rejections is appropriate.

The applicant has traversed the previous 103 rejections of combined references by attacking Casey et al. for alleged deficiency in inherency (Pg. 8, ¶5-Pg.10, ¶5). As set forth in the last ¶, Casey et al. is silent by does not teaches away form the claimed range of gelation index 1 and 2. As to claims 2, 15, 17, and 19, the deficiency of Casey et al. has been addressed and alleviated by Wang et al. As to claims 1, 8 and 14, the deficiency of Deckwer et al. has been addressed and alleviated by Casey et al. As to claims 1-2 and 13, the deficiency of Deckwer et al. has been addressed and alleviated by Casey et al. and Wang et al. As to claims 4-7 and 12, the deficiency of Wang et al. has been addressed and alleviated by Casey et al. and Wang et al. One of ordinary skill in the art would have combined cited references to form the claimed compositions and their inherent gelation index 1 and 2.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANE FANG whose telephone number is (571)270-7378. The examiner can normally be reached on Mon.-Thurs. 8 a.m. to 6:30 p.m. EST.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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